

REMARKS

Claims 13-24 are pending. Claim 17 was amended solely to improve its form by reciting the USPTO's currently preferred preamble language for article of manufacture claims.

Withdrawal of the outstanding rejections is respectfully requested for at least the reasons set forth below.

Request for Interview Prior to Formal Action on Amendment

Applicants request an interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicants' undersigned representative to schedule the interview.

Rejection under 35 U.S.C. § 101

Claims 17-20¹ were rejected again for allegedly being directed to non-statutory subject matter, more specifically, for being directed to software, per se, lacking storage on a medium which enables any underlying functionality to occur. Applicants respectfully traverses this rejection.

In the previous response, Applicants argued that claim 17 explicitly recites an article of manufacture...that comprises a storage medium (i.e., "computer-readable medium holding computer-executable instructions," now recited as "computer-readable medium encoded with computer-executable instructions,") which enables the underlying functionality to occur, and therefore, claim 17 is patentable even under the Examiner's asserted standard.

In the Final Rejection, the Examiner did not respond to this argument, but instead added the following additional explanation to the § 101 rejection (underlining added for emphasis):

¹ Paragraph 3, first sentence, of the Final Rejection refers only to claim 17, but the following sentence refers to claims 17-20. It is thus presumed that the Examiner meant to reject claims 17-20.

Computer readable medium appears in the preamble. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is insufficient written description for this limitation in the specification. The Computer readable medium is given the broadest reasonable interpretation, which renders the Computer readable medium nonstatutory.

First, Applicants do not understand the Examiner's latest explanation. The Examiner's reasoning appears to be based upon an alleged failure to meet 35 U.S.C. § 112, first paragraph. However, no rejection under 35 U.S.C. § 112, first paragraph, was made, nor would such a rejection be proper because the claimed invention is fully supported by the disclosure.

Second, Figures 1-20 and the five Appendices provide detailed embodiments of computer-executable instructions that are encoded on a computer-readable medium. Additionally, page 15, lines 22-26 of the specification, which reads as follows, further supports the article of manufacture claims (underlining added for emphasis):

The present invention can be included in an article of manufacture (e.g., one or more computer program products) having, for instance, computer useable media. The media has embodied therein, for instance, computer readable program code means for providing and facilitating the mechanisms of the present invention. The article of manufacture can be included as part of a computer system or sold separately.

Applicants do not dispute the Examiner's right to give the "computer readable medium" its broadest possible interpretation, but it is unclear why such an interpretation would render these claims as being non-statutory in view of the extensive disclosure that supports this limitation.

The claimed article of manufacture format has been accepted by the USPTO in thousands of software-related patents as a permissible way to claim protection for the software code, per se, that performs a computer-implemented method. Applicants are unaware of any change in USPTO policy regarding this claim format. Accordingly, withdrawal of this rejection is respectfully requested.

Notwithstanding the above, if upon further research, the Examiner believes that this rejection is arguably sustainable, to advance prosecution of the application, Applicants are agreeable to recite the preamble in an alternative format, such as the format used in claim 13 of U.S. Patent No. 6,965,892², which was issued by the Examiner.

Rejections under 35 U.S.C. § 102

1. Patentability of claims 13-24 over Pettersen

All pending claims were rejected again under 35 U.S.C. § 102(e) as allegedly being anticipated by Pettersen. Applicants respectfully traverse this rejection.

In the previous response, Applicants presented a “Declaration of Prior Invention to Overcome Cited Patent” under 37 CFR § 1.131 to swear behind the earliest effective date of Pettersen, which is July 15, 2000, the filing date of Pettersen’s patent application. In the Final Rejection, the Examiner responded by stating that the submitted documentation is insufficient to show reduction to practice of the claimed invention.

In the paragraph spanning pages 6-7 of the Final Rejection, the Examiner merely repeats a quotation from MPEP 715.07, Section I. General Requirements. However, Applicants complied with such requirements.

In the first full paragraph on page 7 of the Final Rejection, the Examiner states that Applicant has not explained how the exhibits support the claimed invention. Applicants traverse this statement. Exemplary claim 13 reads as follows:

13. A method of constructing a web page that allows for syndication of digital assets, the method comprising:
 - (a) constructing a web page; and
 - (b) inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page, wherein the script, when executed by a browser, requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of the web page and a unique identifier of the selected content.

² 13. “At least one program storage device readable by a machine, tangibly embodying at least one program of instructions executable by the machine to perform a method of...”

Applicants' Declaration includes the following supporting statements regarding the source code in Appendix A (underlining added for emphasis):

2. The Affiliate Setup Instructions in Exhibit 2 were created prior to July 15, 2000, as evidenced by the 2/3/2000 "Date Modified" field shown on the associated .doc file in Exhibit 3. The syndication process described in the Affiliate Setup Instructions uses the source code in Appendix A.

3. Execution of the source code in Appendix A will implement the claimed invention and the jSyndicate code shown in the Affiliate Setup Instructions implements the claimed invention. That is, each pending claim limitation is supported by documentation that is dated prior to July 15, 2000.

These supporting statements give a clear explanation to one of ordinary skill in the art of exactly what facts are being established and relied upon. Here, an artisan merely has to look at the source code to see that it implements the claimed invention.

Referring to *In re Harry* cited in the portion of MPEP 715.07 highlighted by the Examiner, the CCPA criticized the showing made by inventor Harry as follows:

...the first affidavit merely says the subject matter of a drawing annexed "was diligently reduced to practice." The second affidavit says "steps were taken to reduce the invention to practice in a commercial size unit by engineering preparation of drawings, cost estimates and both construction and installation of apparatus embodying the invention was done as promptly as possible in all the circumstances." This is not proof or "showing of facts" but mere pleading. It asserts that facts exist but does not tell what they are or when they occurred. 142 USPQ 164 at 166.

In contrast to *In re Harry*, Applicants' exhibits leave nothing to the imagination about what facts are being relied upon for a showing of actual reduction to practice. Furthermore, Applicants are not showing prior invention by conception and diligent reduction to practice, and thus *In re Harry* does not provide a fact pattern that is relevant to the present Declaration.

Referring to *In re Borkowski* also cited in the portion of MPEP 715.07 highlighted by the Examiner, the CCPA criticized the showing made by the inventors by asserting that the "Invention Disclosure" of Exhibit 1 cannot itself establish a reduction to practice, and that the

notebook pages of Exhibits 2 and 3 were not clear on their face regarding proof of acts amounting to reduction to practice. 184 USPQ 29 at 33. In contrast to *In re Borkowski*, Applicants' exhibits are not concept documents about how an invention would work if built, and do not require any piecing together of ideas on laboratory notebook pages to form the completed invention.

In the second full paragraph on page 7 of the Final Rejection, the Examiner states that proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. Applicants agree that such a showing is required and believes that at least Supporting statement 3 of the Declaration (repeated above) provides such a showing.

In the third full paragraph on page 7 of the Final Rejection, the Examiner characterizes Appendix A as establishing, at best, the conception of retrieving content from the Publisher server. Applicants traverse this characterization of Appendix A. Supporting statement 3 of the Declaration attests that "Execution of the source code in Appendix A will implement the claimed invention," which includes the steps of exemplary claim 13, and not just retrieving content from the Publisher server.

In the fourth full paragraph on page 7 of the Final Rejection, the Examiner asserts that Exhibits 1-3 do not constitute an actual reduction of practice. However, the Examiner provides no explanation for this erroneous conclusory statement. Exhibits 1-3 were submitted precisely to show an actual reduction to practice.

In the paragraph spanning pages 7-8 of the Final Rejection, the Examiner states that only the filing of a patent application constitutes a constructive reduction to practice and that the requirements of 35 U.S.C. § 112 must be met. This is correct, but is irrelevant to the present situation. Applicants presented the Declaration with Exhibits 1-3 to show that an actual reduction to practice occurred before the critical date. Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. MPEP 2138.05. Applicants' Declaration addresses the former (actual reduction), not the latter (constructive reduction). As further discussed in Section II of MPEP 2138.05 which relates to interference proceedings but is equally relevant here, "...a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference

count, and (2) the embodiment or process operated for its intended purpose.” *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000). Here, Exhibits 1-3 clearly meet this test.

As further guidance regarding reduction to practice, Section III of MPEP 715.07 provides the following explanation (underlining added for emphasis):

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) >(actual)< reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)...

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

Again, Exhibits 1-3, coupled with the supporting statements, meets the burden to show actual reduction to practice.

In sum, the Examiner’s conclusion that Applicants’ showing is inadequate is misplaced and reconsideration of this conclusion is respectfully requested.

Conclusion

Insofar as the Examiner’s rejections were fully addressed, the instant application is in condition for allowance. A Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

RICHARD D. MARTIN et al.

September 4, 2007 By: Clark Jabolon
(Date) CLARK A. JABLON
Registration No. 35,039
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street - Suite 2200
Philadelphia, PA 19103
Telephone: (215) 965-1200
Direct Dial: (215) 965-1293
Facsimile: (215) 965-1210

CAJ/gem